C. REMARKS

Claims 1-16 remain pending herein. Claims 1, 8, 9, 10, 13, and 14 are currently amended.

Applicants' Agent appreciates the opportunity to have had an interview with the Examiner on October 26, 2004. Applicant's clarifications of claim 1 were discussed, including that the character string is entered at the IP client, that the checking and correcting of the character string is at the IP client, that the typing errors are predefined, that the correcting of the character string produces a corrected URI character string without input from a user, and that the corrected URI character string is submitted without input from a user.

The amendments made herein were made for the purposes of clarity and are supported by the specification, see page 2, paragraphs [0017], [0018], and [0021].

Claims 1-16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider (US Patent No. 6,338,082 B1) in view of Nielsen (US Patent No. 5,907,680). As will shown below, neither Schneider nor Nielsen, either alone or in combination, teaches or suggests a method, data processing system, or computer program product for correcting a character string entered at an IP client as claimed in the present application. Claims 1-16 are therefore patentable and should be allowed. Applicant respectfully traverses each rejection individually, and requests reconsideration of claims 1-16.

Claim Rejections – 35 U.S.C. § 103

Claims 1-16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider (US Patent No. 6,338,082 B1) in view of Nielsen (US Patent No. 5,907,680). Applicant respectfully traverses each rejection, and submits that Examiner's rejections are overcome with the present amendments, and as clarified herein. To establish a prima facie case of obviousness, three basic criteria must be met.[1] First, the combination must teach or suggest all of Applicant's

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[1] Manual of Patent Examining Procedure §2142.

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claim limitations.[2] Second, there must be a suggestion or motivation to combine the references.[3]

Finally, there must be a reasonable expectation of success in the combination.[4]

Schneider and Nielsen

Claims 1-16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider

(US Patent No. 6,338,082 B1) in view of Nielsen (US Patent No. 5,907,680). The combination

of Schneider and Nielsen cannot establish a prima facie case of obviousness because the

proposed combination does not teach each and every element of claims 1-16, there is no

suggestion or motivation to make the proposed combination, and there is no reasonable

expectation of success in the proposed combination.

The combination Of Schneider and Nielsen
Does Not Teach all Of Applicant's Claim Limitation

The combination of Schneider and Nielsen does not teach or suggest all of Applicant's

claim limitation. The present application is entitled "Auto-Correcting URL-Parser". The

Schneider patent is directed to a method and apparatus for requesting a network resource. In

particular, if no resource is found for the request as entered, a network registration service is

queried in an attempt to determine the resource name requested (Schneider Col 7, Lines 47-

55). The network is therefore used to "correct" an inaccurately entered request.

Nielsen is directed to a method and apparatus for spell checking URL requests. The

system teaches recognizing a "server not found" error from the network and then employing

client, server and collaborative processing to attempt to "correct" the URL in the resource request

(Nielsen, FIG 2).

It is respectfully submitted that neither Schneider nor Nielsen, considered singly or in

combination, teach or suggest the presently claimed invention.

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[2] *In re Royka,* 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).
[3] *In re Vaeck,* 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).
[4] *In re Merck & Co., Inc.,* 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986).

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The following discussion considers each element of claim 1 in sequence:

Schneider and Nielsen Do Not Teach Or Suggest Upon Receipt Of The Character String At The Client, Checking The Character String For Typing Errors At The Client.

Applicant amends claim 1 to further clarify this claimed limitation. Neither Schneider nor Nielsen teach or suggest "checking the character string for typing errors at the client". The Examiner argues that Schneider teaches "upon receipt of the character string at the client", however, that phrase is not the entire element. Notwithstanding the fact that the quoted phrase is not a full claim element, the only action Schneider teaches on receipt of a character string is to test for period or blank delimiters. There is no teaching or suggestion of checking for typing errors as claimed.

Nielsen also does not teach or suggest "checking the character string for typing errors" and, in fact, teaches against such a practice. The portions of Nielsen cited by the Examiner (Col. 2, lines 15-50) include a discussion of "traditional spelling checkers" that permit the user to select a word to correct a misspelling. The passage cited by the Examiner includes the specific teaching that "These spelling check capabilities ... are not sufficiently robust or extensive to solve the general problem of spelling errors in manually entered URLs" (Col. 2, lines 8-11). The traditional spelling check capabilities described by Nielsen result only in the presenting of a list of candidate corrections. Nielsen therefore explicitly teaches away from a client based spelling checker.

Schneider Or Nielsen, Alone Or In Combination, Do Not Teach Or Suggest Upon Detection Of A Typing Error, Correcting The Typing Error At The Client, Without Input From A User To Produce A Corrected URI Character String.

Applicant amends claim 1 to further clarify this claimed limitation. The Examiner admits that Schneider does not teach "upon detection of a typing error, correcting a typing error, absent

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[without] input from a user to produce a corrected [URI] character string". The Examiner argues that Nielsen teaches this element. Responsive to Examiner's rejection, Applicant amends claim 1 to further clarify this element. However, a reading of the reference does not support Examiner's argument. Nielsen performs URL verification in response to a "Server Not Found" message (Col. 6, Lines 9-41) and not "upon detection of a typing error" as presently claimed. Further, Nielsen performs corrective actions only after presenting a list to the user for selection. This again teaches away from the presently claimed method to "correct a typing error, without input from a user to produce a corrected character string".

Although the Examiner concludes, "It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a feature, wherein the error detection/correction for typing error for character string feature is embedded in a system with IP client" (Office Action page 3), there is no support in either reference for such a conclusion. In fact, as pointed out above, Nielsen explicitly teaches away from such a "simplistic" feature.

Schneider Or Nielsen, Alone Or In Combination, Do Not Teach Or Suggest Upon Producing The Corrected URI Character String, Submitting the Corrected URI Character String.

Applicant amends claim 1 to further clarify this limitation. Schneider teaches that "Rather than displaying an error message...in response to the determination of an unresolvable URI (step 242) or domain name in (step 260), ... the unresolvable URI is instead redirected to a registration service" (Col. 13, Lines 34-40). Thus, Schneider connects to a registration server and does not submit the corrected URI character string as claimed by Applicant.

Nielsen teaches that "the client side component...creates a list of potentially valid URLs (210). If the created list is not empty (212) then the list is displayed to the user...The user may then select on of the generated URLs (216) or cancel the operation (216)". Thus, Nielsen teaches that the user must make a URL selection from the displayed list, does not teach or suggest Applicant's claimed invention, and teaches away from "upon producing the

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corrected URI character string, submitting the corrected URI character string" as claimed by Applicant.

Any proposed combination of Schneider and Nielsen also does not teach or suggest Applicant's claimed invention, and instead teach away from "upon producing the corrected URI character string, submitting the corrected URI character string", since Schneider redirects to another site (i.e., the registration server) and not the corrected site, and if combined with Nielsen, would present a list to the user to make a further selection, and still does not submit any corrected URI character string as claimed by applicants.

No Suggestion Or Motivation To Modify Schneider Or To Combine Schneider With Nielsen.

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify Schneider, or to combine Schneider with Nielsen. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to modify Schneider must come from the teaching of Schneider itself, and the Examiner must explicitly point to the teaching within Schneider suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicant's own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F,.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

Examiner states in Office Action at page 3 the rationale for motivation to combine:
"One of the ordinary skills in the art would have been motivated to perform such a modification to perform a simplistic spell check on manual enter URL (Internet Protocol) for error correction, fast access, and update the knowledge base that will assist all future users, as taught by Nielsen at Col. 2, lines 1-55 (i.e. ...spell check on manual enter URL...)".

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In Schneider, if no resource is found for the request as entered, a network registration service is queried in an attempt to determine the resource name requested. The network is therefore used to "correct" an inaccurately entered request.

In Nielsen, a sophisticated spell check method is performed to increase the probability of finding the desired WWW in a timely fashion (Col. 2, Lines 16-18) employing client, server and collaborative processing to attempt to "correct" the URL in the resource request.

The suggestion to modify Schneider must come from a teaching within Schneider, not from Nielsen. The Examiner must point to teaching within Schneider suggesting "upon receipt of the character string, checking the character string for typing errors at the client, upon detection of a typing error, correcting the typing error at the client, without input from a user to produce a corrected URI character string, and upon producing the corrected URI character string, submitting the corrected URI character string". It is not possible to find such a teaching in Schneider because Schneider is concerned with finding a resource as entered, and subsequently to not finding it, querying a registration service.

Furthermore, the Examiner must point to teaching within Schneider that identifies typing errors as predefined according to the context within the meaning of the claims of the present invention.

In both Schneider and Nielsen, typing errors are not predefined, thus it is impossible to point to teaching suggesting correction of predefined typing errors.

In addition, the Examiner must point to teaching within Schneider upon detection of a typing error, correcting the typing error at the client, without input from a user to produce a corrected URI character string. Even in Nielsen, the correction of a typing error is performed using the traditional spelling check capabilities which result only in presenting a list of candidate corrections, therefore explicitly teaching away from the presently claimed method to "correct a typing error, without input from a user to produce a corrected URI character string." It is impossible to find such a suggestion to modify Schneider as it is clear that Schneider is not concerned with correcting typing errors as claimed by Applicant, and Nielsen teaches away from Applicant's claimed invention.

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Furthermore, in the Nielsen principle of operation "in each of the apparatus described, the one or more alternative spellings are presented in a form, such as HTML so that the remote user can select one of the alternative spellings...and attempt to connect again using the selected alternative spelling" (emphasis added) (Col. 3, Lines 24-28). There is no motivation to modify or combine Nielsen with Schneider to produce Applicants' claimed invention because the proposed combination would change the principle of operation of Nielsen, and would render Nielsen unsatisfactory for its intended purpose. Since Nielsen teaches that a list of alternative spellings is displayed, and that the user selects one of the alternative spellings, which if combined with the Schneider teaching redirecting to a registration server, the proposed combination would automatically redirect to a registration server, thus violate Nielsen's principle of operation of a user selecting alternative options.

Also, there is no motivation to modify or combine Schneider with Nielsen to produce Applicant's claimed invention because the proposed combination would change the principle of operation of Schneider, and would render Schneider unsatisfactory for its intended purpose. Since Schneider's principle of operation of automatically connecting to a registration server without allowing the user to select a registration site, which if combined with Nielsen to display a list of registration sites, would render Schneider unsatisfactory for their intended purpose to automatically perform a registration request.

Thus, Applicant submits that there is no suggestion or motivation to combine Schneider with Nielsen to produce Applicant's claimed invention because the combination of the teachings of Schneider and Nielsen render the each teaching unsatisfactory for its intended purpose. *In Re Tatti*, 270 F2d 810, 123 USPQ 349 (CCPA 1959), *in re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

<u>Schneider and Nielsen Teach Away From Upon Receipt Of The Character String At The Client, Checking The Character String For Typing Errors At The Client.</u>

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Turning now to the substance of both Schneider and Nielsen, both teach away from Applicant's claimed invention. Teaching away from the claims is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987).

Schneider teaches the method for requesting a network resource from an identifier by determining whether the network can be located (Col 7, Lines 47-55) by making a network request. Nielsen teaches the apparatus for checking spelling of network addresses using databases that contain valid names which did not result in a connection (FIG 2). In Nielsen, the determination of whether a spelling is correct is achieved subsequent to the attempt to locate the resource (FIG 2: 202 and 204). As claimed in the present invention, no attempt is made or needed to locate the resource prior to correcting the error, particularly without requiring network access, which is in contrast to that taught by both Schneider and Nielsen. Thus, Schneider and Nielsen teach away from "upon the detection of a typing error at the client, correcting the typing error at the client, without input from a user to produce a corrected URI character string" as claimed by Applicant.

Schneider and Nielsen Teach Away From Upon Detection of a Typing Error, Correcting The Typing Error At The Client, Without Input From A User To Produce A Corrected URI Character String

Schneider teaches that if URI or domain name is not resolvable, a registration request is made (Fig. 4b). Schneider teaches away from Applicant's claimed invention because the URI of the registration server in the Schneider teaching is some other URI but not the corrected URI indicated by the user.

Nielsen teaches presenting to a user one or more alternative spellings of an address, so that a user can select one alternative spelling (Col 6, Lines 16-20). As claimed in the present invention, the correction of a typing error is accomplished without input from a user to produce a

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corrected URI character string. Thus, Nielsen teaches away from the present claimed invention since Nielsen displays alternative spellings which are presented to the user for user selection, requiring user input.

Nielsen Teaches Away From Upon Producing The Corrected URI Character String, Submitting The Corrected URI Character String.

Nielsen teaches presenting to a user one or more alternative spellings of an address, so that a user can select one alternative spelling (Col 6, Lines 16-20). As claimed in the present invention, once a corrected URI character string is produced, the URI is submitted, in contrast with Nielsen, which teaches away from the present claimed invention because Nielsen displays alternative spellings which are presented to the user for user selection, and does not submit a URI character string from the displayed list.

Schneider and Nielsen Teach Away From Applicant's Definition Of Typing Errors.

As claimed in the present invention, typing, spelling, and punctuation errors are predefined. Applicant's disclosed definition of what constitutes such an error uses a list that can be configured to add errors that a user typically makes (Page 2, paragraphs [0016]-[0019]). The behavior of other users does not affect the behavior of any user in the present invention. A "typing error" as claimed in the present application is predefined by each individual user (Page 1, paragraph [0006]) and is detected and corrected before any transmission, saving time and bandwidth. Schneider and Nielsen teach away from the types of errors as defined by Applicant.

Schneider teaches that "URI resolvability is the determination of domain name resolvability in step 260" (Col 13, Lines 32-34). Nowhere does Schneider teach predefined resolvability, and teaches away from Applicant's definition of predefined errors.

Nielsen teaches the analysis of network addresses, used in an attempt to establish a connection to that address but which did not result in a connection to that address by

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comparing portions of that address with a first, second or third databases, containing corresponding information. (Col. 7, Line 47–Col. 8, Line 23). As claimed in the present invention, "errors are predefined", and the correction information is also predefined for the corresponding predefined typing errors. Thus, Nielsen teaches away from Applicant's correction of predefined errors that are unique to a certain user.

Also, Nielsen teaches away from "typing errors that are predefined" wherein the collaborative component of that invention utilizes knowledge from the user's behavior (i.e, the WWW pages they have successfully retrieved in the past by all users) to provide a knowledge base for the spelling checking (Col. 3, Line 64-Col. 4- Line 7). Thus, Nielsen teaches away from Applicant's claimed invention by utilizing knowledge from the user's behavior and not the correction of predefined errors that are unique to a certain user.

Therefore, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness under 35 USC 103(a) with respect to claim 1. Withdrawal of the rejection of claim 1 is respectfully requested.

In regard to Examiner's rejection of dependent claim 2, as taught by Schneider (Col. 11, lines 17-33), 'the determination of a typing errors "selected from punctuation errors" in step 214 that input 210 has no "." delimiters or " " delimiters only, it becomes clear that there is no domain name or IP address and the input 210 is process as a search request in step 218.', the teaching by Schneider is contrary to Applicant claimed method "where the typing errors are selected from punctuation errors and spelling errors". Applicant's definition of what constitutes a typing error, and the method to correct "predefined" errors as claimed is per Applicant's specification Page 2, paragraph [0018] which states "the application scans the URL for predefined errors and corrects the errors upon detection". Furthermore, in Page 2, paragraph [0019], Applicant discloses 'the list of correction can be configured to add errors that a user typically makes, such as replacing "co" with "com"'. In the Schneider teaching, where the client has no control in defining what constitutes a typing error,

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Schneider teaches away from Applicant's claim "wherein the typing errors are selected from punctuation errors and spelling errors" as defined and claimed by Applicant, which provides an IP client the determination of what constitutes a typing error, and the method how to correct these predefined typing errors.

Therefore, in view of the foregoing, Applicant respectfully submits that the Examiner has not proven prima facie obviousness for claim 2, and for claim 1 from which claim 2 depends, and respectfully requests allowance of claim 2. In addition, Applicant requests allowance of system claim 11 that corresponds with allowable claim 2.

In regard to Examiner's rejection of dependent claim 3, Schneider teaches away from Applicant's claim. Applicant's correction of a typing error, including a punctuation errors as claimed, uses a predefined error list (Page 2, paragraph [0018]-[0019]), regardless of whether a prefix http:// is valid or missing, and the correction of the typing error claimed by Applicant is not taught by Schneider. The typing errors claimed by Applicant uses the scheme that constitutes a correction using 'the list of corrections [that] can be configured to add errors that a user typically makes, such as replacing "co" with "com"'. Thus, Schneider teaches away from Applicant's claim "when the typing error is a punctuation error, replacing the punctuation error with a correct punctuation mark."

Therefore, in view of the foregoing, Applicant respectfully submits that the Examiner has not proven prima facie obviousness for claim 3, and for claim 1 from which claim 3 depends, and respectfully requests allowance of claim 3.

In regard to Examiner's rejection of dependent claim 4, Schneider teaches away from upon detection of a typing error, correcting the typing error, without input from a user to produce a corrected URI character string "where the typing error is a spelling error, replacing the spelling error with a correct spelling" as claimed by Applicant.

In contrast with the teaching of Schneider, Applicant's invention does not "list the corrected URL to the user" and the "list of URLs is" not "displayed to the user in a hypertext

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format where the user can either select one of the URLs or cancel". Thus, Schneider teaches away from Applicant's method of correction is without input from a user to produce a corrected URI character string "when the typing error is a spelling error, replacing the spelling error with a correct spelling".

Therefore, in view of the foregoing, Applicant respectfully submits that the Examiner has not proven prima facie obviousness for claim 4, and for claim 2 from which claim 4 depends, and respectfully requests allowance of claim 4.

In regards to Examiner's rejection of claim 5, as taught by Schneider, the concept of "typing errors are predefined" is non-existent, and in particular it is lacking where one user makes the determination of whether or not a string is in error and another user may use the same string and make a different determination. In Schneider, Col. 12, Lines 29-43,

"Specific steps for the determination of domain name resolvability (step 260) include issuing a function call in step 264 from the web browser 112 to gethostbyname( ) from the resolver library 114 to translate the domain name into its corresponding IP address from the DNS database 124 of a DNS server system 120'. When gethostbyname( ) returns a NULL pointer in step 264, then it is determined in step 268 that no IP address is found and a browser error message is displayed in step 230. However, when an IP address is found in step 268, then a request is submitted to access the server located at the IP address. When the server is found in step 254 and accessed, results, if any, are then notified, accessed, and/or displayed in step 222. However, if the server is not found in step 254, a browser error message is displayed in step 230."

In Contrast, Applicant's claim 5 "wherein typing errors are predefined" yield totally different and unexpected results wherein one user who "predefines" one mistyped domain name, from another who "predefines" a differently mistyped domain name. Applicant's typing errors are predefined and can be customized to correct errors unique to a certain user. Thus, Schneider teaches away from predefined errors, where errors are predefined specifically by a certain user, and not globally as it is taught in Schneider.

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Schneider teaches "determination of domain name resolvability" and teaches away from correcting errors "wherein the typing errors are predefined" as claimed in the present invention.

Therefore, in view of the foregoing, Applicant respectfully submits that the Examiner has not proven prima facie obviousness for claim 5, and for claim 1 from which claim 5 depends, and respectfully requests allowance of claim 5. In addition, applicant requests allowance of system claim 12 and computer readable medium claim 16 that also correspond with allowable claim 5,

In regards to Examiner's rejection of claim 6, Nielsen does not teach that "spelling errors are predefined", and in particular where one user makes the determination of whether or not a string is in fact in error, and another user may use the same string and make a different determination. In Nielsen, at Col. 7, lines 8-17, "If the list becomes empty (314) and the list previously held constructed URLs (324) then the user is given a message stating that none of the constructed URLs were valid (336) and the process is terminated (332)". Thus, Nielsen teaches away from Applicant's invention "where spelling errors are predefined".

Therefore, in view of the foregoing, Applicant respectfully submits that the Examiner has not proven prima facie obviousness for claim 6, and for claim 2 from which claim 6 depends, and respectfully requests allowance of claim 6.

In regards to Examiner's rejection of claim 7, Schneider does not teach that "typing errors are predefined", and in particular where one user makes the determination of whether or not a string is in fact in error, and another user may use the same string and make a different determination. In Schneider, Col. 12, lines 29-43, the "Specific steps for the determination of domain name resolvability (step 260) include issuing a function call in step 264 from the web browser 112 to gethostbyname( ) from the resolver library... However, if the server is not found in step 254, a browser error message is displayed in step 230." In

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Contrast, Applicant's claim 7 "wherein punctuation errors are predefined" yield totally different and unexpected results wherein one user who "predefines" one mistyped domain name, from another who "predefines" a differently mistyped domain name. Thus, the definition of "errors" lies specifically with a certain user, and not "utilizing knowledge obtained from other users behavior" as it is taught by Schneider.

Schneider teaches "determination of domain name resolvability" and teaches away from correcting errors "wherein the typing errors are predefined" as claimed by Applicant in the present invention.

Therefore, in view of the foregoing, Applicant respectfully submits that the Examiner has not proven prima facie obviousness for claim 7, and for claim 2 from which claim 7 depends, and respectfully requests allowance of claim 7.

In regards to Examiner's rejection of claim 8, claim 8 is amended for clarity purpose. Applicant's response is similar to Applicant's response made for claim 1. Therefore, Applicant respectfully submits that the Examiner has not proven prima facie obviousness for 8, for claim 1 from which claim 8 depends, and therefore amended dependent claim 8 should be allowed.

In regard to Examiner's rejection of claim 9, Applicant response amends claim 9 is for clarity purpose, and Applicant's response is similar to Applicant's response made for claim 1. Therefore, Applicant respectfully submits that the Examiner has not proven prima facie obviousness for claim 9 and for claim 1, and therefore amended claim 9 should be allowed.

In regard to Examiner's rejection of independent claim 10, claim 10 is currently amended for clarity purpose, and Applicant's response is similar to Applicant's response made for claim 1. Therefore, Applicant respectfully submits that the Examiner has not proven prima

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facie obviousness for claims 10 and 1, and therefore amended dependent claim 10 should be allowed.

In regard to Examiner's rejection of claim 11, Applicant's response is similar to Applicant's response made for claims 2 and 10. Therefore, Applicant respectfully submits that the Examiner has not proven prima facie obviousness for claims 2 and 10, and therefore dependent claim 11 should be allowed.

In regard to Examiner's rejection of dependent claim 12, Applicant's response is similar to Applicant's response made for claim 5 and 10. Therefore, Applicant respectfully submits that the Examiner has not proven prima facie obviousness for claim 12, and therefore dependent claim 12 should be allowed.

In regard to Examiner's rejection of dependent claim 13, Applicant's response amends claim 13 for clarity purpose, and response is similar to Applicant's response made for claims 1 and 10. Therefore, Applicant respectfully submits that the Examiner has not proven prima facie obviousness for claim 13, and therefore dependent claim 13 should not be rejected.

Applicant currently amended claim 14 for clarity purpose, and response to Examiner's rejection of computer program product claim 14 is similar to Applicant's response made for method claim 1, additionally respectfully submitting that the Examiner has not proven prima facie obviousness as follows:

<u>Schneider and Nielsen Teach Away From Selectively
Preventing Collection Of History Information</u>

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Schneider and Nielsen teach away from selectively preventing collection of history information as claimed in Applicant's claim 14. In Schneider, determination whether the network resource can be located is made requesting the network resource. (Schneider, Col 7, Lines 47-55). In Nielsen, an attempt to establish a connection is made. (Nielsen, FIG 2). As in both teachings, it is well known in the art that browser history is collected during the attempt to locate or establish a connection. As claimed in the present invention, instructions are provided to selectively prevent collection of browser history.

Thus, Applicant's response to Examiner's rejection of computer program product claim 14 submit that Schneider and Nielsen teach away from selectively preventing collection of history information as claimed in Applicant's claim 14, in addition to the Applicant's response above for similar method claim 1. Therefore, Applicant respectfully submits that the Examiner has not proven prima facie obviousness for claims 1 and 14, and therefore amended claim 14 should be allowed.

In regard to Examiner's rejection of dependent claim 15, Applicant's response is similar to Applicant's response made for claims 3 and 14. Therefore, Applicant respectfully submits that the Examiner has not proven prima facie obviousness for claim 3, 14 and 15, and therefore dependent claim 15 should be allowed.

In regard to Examiner's rejection of dependent claim 16, Applicant's response is similar to Applicant's response made for claim 5 and 14. Therefore, Applicant respectfully submits that the Examiner has not proven prima facie obviousness for claim 5, 14 and 16, and therefore dependent claim 16 should be allowed.
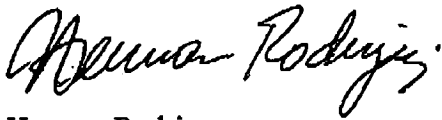
Conclusion

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Claims 1-16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider (US Patent No. 6,338,082 B1) in view of Nielsen (US Patent No. 5,907,680). For the reasons set forth above, including Applicant's amendments to claims 1, 8, 9, 10, 13 and 14, Examiner's proposed modification of Schneider in view of Nielsen fails to establish a prima face case of obviousness. The rejection of claims 1-16 should therefore be withdrawn, and the claims should be allowed. Reconsideration of claims 1-16 in light of the present remarks is respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment.

Respectfully submitted,

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